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EXAMINER
HOANG, HIEU T

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		10/776,293	STEWART, BRETT B.
		Examiner	Art Unit	
		HIEU HOANG	2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>04 November 2010</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1,2,4-20,25-32,44-46,84-91,127-138,176,177 and 188_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-2, 4-20, 25-32, 44-46, 84-91, 127-138, 176-177, 188_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on //2010

has been entered.

2.   Claims 3, 21-24, 33-43, 47-83, 92-126, 139-175 and 178-187 are cancelled.

3.   Claims 1-2, 4-20, 25-32, 44-46, 84-91, 127-138, 176-177, 188 are pending.

Response to Amendment

4.   The double patenting rejection has been maintained. Applicant has not acted on

the double patenting rejection.

5.   The restriction requirement has been withdrawn.

Response to Arguments

6.   Applicant's arguments on the 35 U.S.C 103 rejection have been fully considered

but they are unpersuasive. First of all, there is no support for "transmitting… a message

to the user *from* a business promoting goods or services of the business" in the

specification. The specification on page 14 describes at best providing the user with the

promotions information of a business. Therefore, the limitation will be read as

transmitting … a message related to a business promoting goods or services of the

business to the user. It is also maintained that the information such as services in fig. 3

of Muffat qualifies as a message that is relates to a business promoting goods or

services of the business because it promotes the user to use the services. Also, a

message related to a business promoting goods does not mean that the message

actually promotes the goods.

7.   Argument on "the message is selected based on the identification" is

unpersuasive. It is maintained that the prior art does teach "the message is selected

based on the identification information" (Singer, fig. 2, step 54, 70-72, authorization of a

user before location based information can be sent to the user). The identification

information is no more than any user credentials that can be used to authorize the user

so that location based information can be sent (selected) to the user.

Double Patenting

8.   The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees.   A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163

USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)

may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of

activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

9.   Claims 1-2, 4-20, 25-32, 44-46, 84-91, 127-138, 176-177, 188 are provisionally

rejected on the ground of nonstatutory obviousness-type double patenting as being

unpatentable over claims 170, 172-173, 177-178, 180-182, 184-213 of copending

Application No. 11/391,631 as of 01/22/2009 (hereafter '631). Although the conflicting

claims are not identical, they are not patentably distinct from each other because:

10.   For claim 1, '631 teaches determining a geographic location of a computing

device coupled to a network managed by a service provider via an access point ('631,

claim 172); receiving identification information indicating a user of the computing device

('631, claim 170, user profile); determining third party information of a third party that is

dependent on the geographic location of the computing device ('631, claim 170,

advertisement provider); transmitting, via the network and access point, content to the

computing device, wherein the content comprises a message to the user from a

business promoting goods or services of the business relating to the geographic

location of the computing device and wherein the message is selected based on the

identification information and the third party information ('631, claim 170, advertisement

provider provides ads through the access point at the user location based on the access

point location).

Claim 172 of '631 does not explicitly disclose the third party is not the service

provider or the user; and the business is not the service provider or the user.

However, claim 188 of '631 discloses the third party is not the service provider or

the user; and the business is not the service provider or the user ('631, claim 188,

information provider is not WAP provider or user)

It would have been obvious to one skilled in the art at the time of the invention to

have combined the teachings of claims 172 and 188 of '631 to have business

advertisement to be sent from an information service provider or third party distinct from

the network service provider. The motivation would be to allow location-based third

party services via the network and to provide earnings to the third party by providing the

services.

11.   Independent claims 11, 25, 30, 63, 84, and 127 are obvious variances of claim 1

and are therefore rejected for the same rationale.

12.   This is a <u>provisional</u> obviousness-type double patenting rejection because the
conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

13.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
>
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
>
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
>
> set forth the best mode contemplated by the inventor of carrying out his invention.

14.   Claims 1-2, 4-20, 25-32, 44-46, 84-91, 127-138, 176-177, 188 are rejected under
35 U.S.C. 112, first paragraph, as failing to comply with the written description
requirement. The claim(s) contains subject matter which was not described in the
specification in such a way as to reasonably convey to one skilled in the relevant art that
the inventor(s), at the time the application was filed, had possession of the claimed
invention. There is no support for "transmitting… a message to the user ***from*** a
business promoting goods or services of the business" in the specification. The
specification at best on page 14 describes providing the user with the promotions
information of a business.

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as

set forth in section 102 of this title, if the differences between the subject matter sought to be

patented and the prior art are such that the subject matter as a whole would have been obvious

at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. Patentability shall not be negatived by the manner in which the invention

was made.

16.   Claims 1-2, 4-6, 9-10, 44, 188, 25-30, 32, 45-46, 84-91, 176-177 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Singer et al. (US 5,485,163,

hereafter Singer) in view of Muffat et al. (European Cooperation on Dual Mode

Route Guidance-Perspectives for Advanced Research Partners, hereafter Muffat,

cited in IDS).

17.   For claim 1, Singer discloses a method for providing geographic-based

information, the method comprising:

determining a geographic location of a computing device coupled to a network

managed by a service provider via an access point (col. 4 l. 19-22, location of the base

station BTS or access point is forwarded to the HLR—home location register; col. 3 l. 5-

9, cellular service comprising many BTS);

receiving identification information indicating a user of the computing device (fig.

2 step 54, col. 3 lines 1-5, subscriber has identification and device identifier);

transmitting, via the network and access point, content information to another

computing device, wherein the content comprises a message to the user and the

content relating to the geographic location of the computing device and wherein the
message is selected based on the identification information (fig. 2 step 72, HLR sends
back formatted information (col. 2 lines 39-42) based on the location information to a
subscriber's device, via the access point).

Singer does not disclose that the two devices are one combination or can be
used as a combination on one user.

However, it would have been obvious for one skilled in the art at the time of the
invention to modify the teachings of Singer to incorporate the two devices or use two
devices on one user/wearer in order to provide location services to the PLU wearer so
that the user can use both functionalities of the PLU and the receiving device to track
his own location and/or receive location-based information.

Singer does not disclose: determining third party information of a third party that
is dependent on the geographic location of the computing device, wherein the third
party is not the service provider or the user; the message is from a business promoting
goods or services of the business relating to the geographic location, the message is
selected based on the third party information, wherein the business is not the service
provider or the user.

Muffat discloses determining third party information of a third party that is
dependent on the geographic location of the computing device, wherein the third party
is not the service provider or the user; the message is from a business promoting
goods or services of the business relating to the geographic location, the message is
selected based on the third party information, wherein the business is not the service

provider or the user (p. 930, left col., route computation using infrastructure side; fig. 3,

page 934, left column, information services such as promotions of hotels, garages, gas

stations, pharmacies... sent to user mobile device).

It would have been obvious for one skilled in the art at the time of the invention to

apply Muffat's teachings of navigation and location-based services to Singer's teachings

of location reporting. The motivation would be to provide navigation service and

information services that are useful and mostly related to the user's location to the user.

18.   Claims 11, 84, 127 are rejected for the same rationale as in claim 1.

19.   For claim 25, Singer discloses a geographic-based information system,

comprising: a network managed by a service provider (col. 3 l. 5-9, cellular service

comprising many BTS); one or more information providers coupled to the network; one

or more access points coupled to the network and arranged at geographic locations in a

geographic region, wherein a first access point of the one or more access points in

proximity to a plurality of computing devices is operable to communicate with the

plurality of computing devices (fig. 1, BTS 20 is an access point at location of the user

device) information are provided through the network and via the first access point to

the at least two computing devices (fig. 2, col. 3, l. 1-42, col. 4, l. 19-46, providing

location messages to user devices based on different user locations related to access

points of a cellular network, different user devices are supported).

Singer does not disclose: third party information of a third party that is dependent on the geographic location of the computing device, wherein the third party is not the service provider or the user; the first information is based on the third party information, and wherein the first content comprises a message from a first business relating to the geographic location of the first access point; the second information is based on the third party information and wherein the second content comprises a message from a second business relating to the geographic location of the second access point.

Muffat discloses: third party information of a third party that is dependent on the geographic location of the computing device, wherein the third party is not the service provider or the user (fig. 3, page 934, left column, services such as hotels, garage… at user location, not the network provider); the first information is based on the third party information, and wherein the first content comprises a message from a first business relating to the geographic location of the first access point (fig. 3, page 934, left column, services such as hotels, garage… at user location, not the network provider); the second information is based on the third party information and wherein the second content comprises a message from a second business relating to the geographic location of the second access point (p. 930, left col., route computation using infrastructure side; fig. 3, page 934, left column, information services such as promotions of hotels, garages, gas stations, pharmacies… sent to mobile devices, fig. 2, messages to different devices).

It would have been obvious for one skilled in the art at the time of the invention to apply Muffat's teachings of navigation and location-based services to Singer's teachings

of location reporting. The motivation would be to provide navigation service and

information services that are useful and mostly related to the user's location to the user.

20.   For claim 30, Singer discloses method of providing a geographic-based

information in a geographic-based communication system managed b¥ a service

provider, wherein the geographic-based communication system uses a geographic

location of a first access point of one or more access points to service one or more

users in a vicinity of the first access point, the method comprising:

         establishing a first wireless communication link between a first computing device

and the first access point (fig. 2, step 52, user connection to network access point);

identifying a first user of the first computing device in response to said establishing the

first wireless communication link (fig. 2 step 54, user identification); establishing a

second wireless communication link between a second computing device and the first

access point (fig. 2, step 52, user connection to network access point, multiple users are

supported since each user has a personal identification); identifying a second user of

the second computing device in response to said establishing the second wireless

communication link (fig. 2 step 54, user identification); determining the geographic

location of the first access point (fig. 2, step 68-70, find location of access point);

providing the geographic location of the first access point to an information provider (fig.

2, step 70, forwarding location to HLR); transmitting first information from the

information provider to the first computing device via the first access point (fig. 2, step

72, sending formatted location information to the user device via access point), wherein

a first content of the first information is dependent upon the geographic location of the

first access point, and said identifying the first user (fig. 2, step 72, sending formatted

location information to the user device based on access point location and user ID); and

transmitting second information from the information provider to the second computing

device via the first access point (fig. 2, step 72, sending formatted location information

to the user device via access point), wherein a second content of the second

information is dependent upon the geographic location of the first access point (fig. 2,

step 72, sending formatted location information to the user device based on access

point location and user ID), wherein the second content is different from the first content

(fig.2, steps 52-54, different users have different location content).

     Singer does not disclose:

     the first content is dependent on third party information of a third party that is

dependent upon the geographic location of the first access point; wherein the third party

is not the service provider or the first user; wherein the first content comprises a

message to the first user from a first business relating to the geographic location of the

first computing device; and the second content is dependent on third party information

of a third party that is dependent upon the geographic location of the first access point,

wherein the third party is not the service provider or the second user; wherein the

second content comprises a message to the second user from a second business

relating to the geographic location of the computing device.

     Muffat discloses: the first content is dependent on third party information of a

third party that is dependent upon the geographic location of the first access point;

wherein the third party is not the service provider or the first user (fig. 3, page 934, left column, services such as hotels, garage... at user location, not the network provider); wherein the first content comprises a message to the first user from a first business relating to the geographic location of the first computing device (fig. 3, page 934, left column, information services such as promotions of hotels, garages, gas stations, pharmacies... at the user location sent to mobile devices); and the second content is dependent on third party information of a third party that is dependent upon the geographic location of the first access point, wherein the third party is not the service provider or the second user (fig. 3, page 934, left column, services such as hotels, garage... at user location, not the network provider); wherein the second content comprises a message to the second user from a second business relating to the geographic location of the computing device (p. 930, left col., route computation using infrastructure side; fig. 3, page 934, left column, information services such as promotions of hotels, garages, gas stations, pharmacies... sent to mobile devices, fig. 2, messages to different devices).

It would have been obvious for one skilled in the art at the time of the invention to apply Muffat's teachings of navigation and location-based services to Singer's teachings of location reporting. The motivation would be to provide navigation service and information services that are useful and mostly related to the user's location to the user.

21.   For claim 2, Singer-Muffat further discloses the content includes weather information (Muffat, page 934, hazard warning).

22.   For claim 188, Singer-Muffat further discloses the content is further dependent
upon demographic information of the user of the computing device (Singer, col. 3 l. 32-
42).

23.   For claim 4, Singer-Muffat further discloses the demographic information
indicates the content is desired by the user (Singer, col. 3 l. 32-42).

24.   For claim 5, Singer-Muffat further discloses the computing device transmitting the
identification information indicating the user of the computing device (Singer, fig. 2,
steps 52-56).

25.   For claim 6, Singer-Muffat further discloses said determining the geographic
location comprises receiving information regarding a geographic location of the access
point (Singer, fig. 2, step 68).

26.   For claim 9, Singer-Muffat further discloses the geographic location of the access
point is determined by its proximity to another geographic location (Singer, col. 3 l. 40-
42).

27.   For claim 10, Singer-Muffat further discloses the computing device is a portable
computing device (Singer, fig. 1, mobile phone).

28.   For claim 44, Singer-Muffat further discloses receiving a destination; wherein the
content indicates a route from the geographic location of the computing device to the
destination (Muffat, p. 934, left col., route guidance).

29.   For claim 26, Singer-Muffat further discloses a memory coupled to the network
which comprises geographic location information comprising geographic locations of

each of at least a subset of the one or more access points (Singer, col. 4 l. 25-32,

lookup table).

30.   For claims 27, 89, 90, Singer-Muffat further discloses a memory coupled to the

network which comprises geographic location information comprising a local map of an

area of each of at least a subset of the one or more access points (Singer, col. 4 l. 25-

32, Muffat, fig. 3, map).

31.   For claims 28, 91, Singer-Muffat further discloses the network includes one or

more of a local area network and a wide area network (Singer, fig. 1, Muffat fig. 2).

32.   For claims 29, 32, 85, the claims are rejected for the same rationale as in claim

10.

33.   For claims 45, 86, the claims are rejected for the same rationale as in claim 2.

34.   For claim 46, Singer-Muffat further discloses wherein said establishing said first

wireless communication link includes identifying a user of the first computing device;

wherein the content is dependent upon said identifying the user (Singer, fig. 2, steps 52-

56).

35.   For claim 87, Singer-Muffat further discloses the information comprises travel

information (Muffat, fig. 3, route).

36.   For claim 88, Singer-Muffat further discloses the information comprises a nearest

location of a service provider relative to the at least one of the one or more access

points (Muffat, fig. 3, closest parking).

37.   For claim 176, Singer-Muffat further discloses at least a portion of the content is

capable of being displayed to a user of the computing device (Singer, col. 3 l. 32-42).

38.   For claim 177, Singer-Muffat further discloses the computing device is a portable computing device configured to be readily carried by a user (Singer, fig. 1, portable PLU and phone).

39.   For claim 12, Singer-Muffat further discloses the information provider is further configured to receive, from the computing device, identification information indicating the user of the computing device (Singer, fig. 2, step 54).

40.   For claim 13, Singer-Muffat further discloses the content is further dependent upon profile information of the user of the computing device (Singer, fig. 2, step 54).

41.   For claim 14, Singer-Muffat further discloses the system further comprising: the network (Singer, fig. 1).

42.   For claim 15, Singer-Muffat further discloses a memory coupled to the network, wherein the memory includes the geographic location of the first access point (Singer, col. 4 l. 19-32).

43.   Claims 16-20 are rejected for the same rationale as in claims 2, 44, 5, 9, 10 respectively.

44.   Claims 85-87 are rejected for the same rationale as in claims 10, 2, 44
respectively.

45.   For claim 88, Singer-Muffat further discloses at least one of the plurality of
contents includes a nearest location of a service provider relative to the geographic
location of the first access point (Muffat, fig. 3).

46.   For claim 89, Singer-Muffat further discloses a memory coupled to the network
which comprises geographic location information comprising a local map of an area of
each of at least a subset of the one or more access points (Muffat, fig. 3).

47.   For claim 90, Singer-Muffat further discloses a memory coupled to the network
which comprises geographic location information comprising geographic locations of
each of at least a subset of the one or more access points (Muffat, fig. 3).

48.   For claim 91, Singer-Muffat further discloses wherein the network includes one or
more of a local area network and a wide area network (Singer, fig. 1).

**49.   Claims 7, 8, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Singer in view of Muffat, further in view of Labedz et al (US 5,608,854,
hereafter Labedz).**

50.   For claim 7, Singer-Muffat further discloses the geographic location of the access

point is determined by accessing a database, wherein the database comprises

information including the geographic location of the access point (Singer, col. 4 l. 25-32,

lookup table). Singer-Muffat does not disclose a MIB. However, Labedz discloses a MIB

in cellular networks for storing information (col. 3 l. 49-60). It would have been obvious

to one skilled in the art at the time of the invention was made to apply Labedz's MIB to

the teachings of Singer-Muffat. The motivation would be to take advantage of a MIB

being a known and standardized database management solution.

51.   For claim 8, Singer-Muffat-Labedz further discloses the access point comprises a

portion of the MIB, wherein the portion comprises information including the geographic

location of the access point (Singer, col. 4 l. 25-32, lookup table).

52.   Claim 31 is rejected for the same rationale as in claim 7.

Conclusion

53.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Hieu Hoang whose telephone number is 571-270-1253.

The examiner can normally be reached on Monday-Thursday, 8 a.m.-5 p.m., EST.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Thu Nguyen can be reached on 571-272-6967. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hieu Hoang/

Examiner, Art Unit 2452